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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,695	07/20/2001	Joseph A. Hedrick	DX0757K	2825

28008 7590 10/01/2002

DNAX RESEARCH, INC.  
LEGAL DEPARTMENT  
901 CALIFORNIA AVENUE  
PALO ALTO, CA 94304

EXAMINER

MERTZ, PREMA MARIA

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 10/01/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/910,695

Applicant(s)  
Hedrick et al.

Examiner  
Premia Mertz

Art Unit  
1646



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jul 20, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-36 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s): \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s): \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1\*-6\*, 21, drawn to a protein of amino acid sequence set forth in SEQ ID NO:8, classified in class 530, subclass 350.

Group II. Claims 1\*-6\*, drawn to a protein of amino acid sequence set forth in SEQ ID NO:6, classified in class 530, subclass 325.

Group III. Claims 1\*-6\*, drawn to a protein of amino acid sequence set forth in SEQ ID NO:2, classified in class 530, subclass 325.

Group IV. Claims 7\*-10\*, 33-35, drawn to an antibody to the protein of amino acid sequence set forth in SEQ ID NO:8, a kit comprising said antibody and a method of producing an antiserum or antigen-antibody complex, classified in class 530, subclass 387.9.

Group V. Claims 7\*-10\*, drawn to an antibody to the protein of amino acid sequence set forth in SEQ ID NO:6, a kit comprising said antibody and a method of producing an antiserum or antigen-antibody complex, classified in class 530, subclass 387.9.

Group VI. Claims 7\*-10\*, drawn to an antibody to the protein of amino acid sequence set forth in SEQ ID NO:2, a kit comprising said antibody and a method of producing an antiserum or antigen-antibody complex, classified in class 530, subclass 387.9.

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Group VII. Claims 11\*-19\*, 22-27, drawn to a nucleic acid encoding a protein of amino acid sequence set forth in SEQ ID NO:8, a host cell, and a kit comprising said nucleic acid, classified in class 536, subclass 23.5.

Group VIII. Claims 11\*-19\*, drawn to a nucleic acid encoding a protein of amino acid sequence set forth in SEQ ID NO:6, a host cell, and a kit comprising said nucleic acid, classified in class 536, subclass 23.5.

Group IX. Claims 11\*-19\*, drawn to a nucleic acid encoding a protein of amino acid sequence set forth in SEQ ID NO:2, a host cell, and a kit comprising said nucleic acid, classified in class 536, subclass 23.5.

Group X. Claim 20, drawn to a method of screening for a compound comprising contacting said compound to the protein of amino acid sequence set forth in SEQ ID NO:8, class 435, subclass 7.1.

Group XI. Claims 28-32, drawn to a method of treating a wound comprising contacting the host cells with the polynucleotide encoding the protein of amino acid sequence set forth in SEQ ID NO:8, class 514, subclass 44.

Group XII. Claim 36, drawn to a method of treating a wound comprising administering the protein of amino acid sequence set forth in SEQ ID NO:8, class 424, subclass 139.1.

\*These claims embrace multiple patentably distinct embodiments.

The inventions are distinct, each from the other because of the following reasons:

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Inventions I-IX are independent and distinct, each from the other, because they are compositions which possess characteristic differences in structure and function and each has an independent utility, that is distinct for each material composition, which cannot be exchanged. (e.g., the nucleic acid encoding a protein of amino acid sequence set forth in SEQ ID NO:8 cannot be exchanged for a nucleic acid encoding a protein of amino acid sequence set forth in SEQ ID NO:6 since the proteins encoded by the nucleic acids are structurally different). The nucleic acids of inventions VII-IX can be used to make a hybridization probe or can be used in gene therapy as well as in the production of the protein of interest. The proteins of inventions I-III can be used as a probe, or used therapeutically or diagnostically, e.g. in screening. Each of the antibodies of inventions IV-VI can be used to obtain the nucleic acids of Groups VII-IX, respectively, and can also be used in diagnostics, e.g. as a probe in immunoassays.

Inventions I and X, XII, are related as product and processes of use, respectively. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP.. § 806.05(h)). In the instant case the protein can also be used in the production of antibodies to the protein.

Inventions VII and XI, are related as product and processes of use, respectively. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the

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product as claimed can be used in a materially different process of using that product (MPEP.. § 806.05(h)). In the instant case the nucleic acid can also be used in the production of the protein.

Inventions II-IX and X, XII, are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP.. § 806.04, MPEP.. § 808.01). In the instant case the different inventions the inventions are not disclosed as capable of use together.

Inventions I-VI, VIII--IX and X, XII, are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP.. § 806.04, MPEP.. § 808.01). In the instant case the different inventions the inventions are not disclosed as capable of use together.

Inventions X-XII are independent and distinct, each from the other, because the methods are practiced with materially different process steps for materially different purposes and each method requires a non-coextensive search because of different starting materials, process steps and goals.

Having shown that these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter as defined by MPEP.. § 808.02, the Examiner has *prima facie* shown a serious burden of search (see MPEP.. § 803). Therefore, an initial requirement of restriction for examination purposes as indicated is proper.

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Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (703) 308-4229. The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4227. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Prema Mertz*  
Prema Mertz Ph.D.  
Primary Examiner  
Art Unit 1646  
August 22, 2002